

The opinion in support of the decision being entered today was *not* written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANJEEV MADAN,
JAMES R. JASENAK,
and
DAVID L. FAIR

Appeal No. 1997-0956
Application No. 08/313,488

ON BRIEF

Before WINTERS, PAK, and LIEBERMAN, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 12, 14 through 20 and 22, which are all of the claims pending in the application. Claim 1 was amended subsequent to the final

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Office action dated May 14, 1996, Paper No. 5.

Claim 1 is representative of the subject matter on appeal
and reads as follows:

1. A process for the production of a soft composite in a closed mold comprising:

a) applying a composition which forms a soft elastomer that includes a prepolymer of diphenylmethane diisocyanate having an NCO content of from about 8 to about 17% by weight and at least one isocyanate-reactive compound with at least two isocyanate-reactive groups to the interior walls of the open mold:

b) introducing a composition which is made up of

- 1) a mixture of diphenylmethane diisocyanates and/or polyisocyanates having an NCO content of from about 32.0 to about 32.8 which isocyanates are not prepolymers,
- 2) a polyol mixture having a functionality of at least two and molecular weight of from about 400 to about 8,000,
- 3) a blowing agent,
- 4) an amine catalyst, and
- 5) an amine crosslinking agent

and will react to form a low density, high resiliency, flexible foam under molding conditions in an amount such that the formed foam will fill the mold into the mold in a manner such that this composition will be substantially completely within the elastomer-forming composition present on the mold walls;

c) closing the mold
and

d) allowing the composition introduced in b) to form

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a foam.

As evidence of obviousness, the examiner relies on the following prior art:

Ahrens 1980	4,190,697	Feb. 26,
Nishida 1981	4,294,880	Oct. 13,
Debaes et al. (Debaes) 1992	5,116,557	May 26,
Bianchin et al. (Bianchin) 1993	5,223,193	Jun. 29,

The appealed claims stand rejected as follows:¹

(1) Claims 1 through 12, 14 through 17, 19, 20 and 22 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Debaes, Bianchin and Nishida;² and

(2) Claim 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Debaes, Bianchin, Nishida and Ahrens.

We have carefully evaluated the claims, specification and

¹The examiner has withdrawn the § 112 rejections set forth at pages 2-4 of the final Office action dated May 14, 1996. See the Advisory Action dated August 9, 1996, paper number 7.

²In view of the amendment after the final Office action dated May 14, 1996, the examiner has combined the rejections based on Debaes and Bianchin, and Debaes, Bianchin and Nishida. See the Advisory Action dated August 9, 1996, paper number 7.

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applied prior art, including all of the arguments advanced by the

examiner and appellants. This evaluation leads us to conclude that the examiner's § 103 rejections are not well founded for the reasons well articulated by appellants at pages 3-11 of the Brief. We only add that the examiner needs to carry his burden

of establishing a *prima facie* case of obviousness regarding each

and every limitation recited in the claims on appeal before he can require appellants to provide rebuttal evidence, such as a showing of unexpected results. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). Accordingly, for the reasons expressed by appellants at pages 3 through 11 of the Brief, and the reason indicated above, we reverse the examiner's decision rejecting all of the appealed claims under 35 U.S.C. § 103.

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In view of the foregoing, the decision of the examiner is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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)	
PAUL LIEBERMAN)	
Administrative Patent Judge)	

CKP:hh

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